

In response to the request for comments in the March 31, 2000 federal register: I respectfully request consideration of my comments on the proposed PTA practice. Rule numbers below refer to the rules in the Notice of Proposed rulemaking 37 CFR Part 1, Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term.

Comments on proposed PTA practice:

The RCE practice as proposed in the new rules 114 and 704 is not in the community's best interests. The new rules do not provide proper incentive to USPTO personnel to promptly act after an RCE is filed; rather they take away many of the benefits of the Patent Term Adjustment. Proposed rule 703 (b)(1) exempts from the period of adjustment, the number of days from the filing of an RCE until the date a patent issues.

There is no reason that responding to an RCE should be longer than responding to any normal response to an Office action. Normally term extension is available when the Office takes longer than four months to issue an action or notice of allowance following a response. Rule 703(a)(2). The same possibility of term extension should attach to the filing of an RCE.

The RCE filing stops the clock for further patent term adjustment. Rule 703(b)(1). The Applicant loses the time post Issue fee payment that usually would be considered in calculating the term adjustment. Rule 703(a)(6). Filing an RCE should not change the dynamic of processing an allowed application for issue to the extent that Applicant should bear the burden of PTO printing delays.

Filing an RCE also works against the Applicant in case an interference is contemplated or declared by the Office, rule 703(c); in case of an application under secrecy order, rule 703(d); or in the case of appeal to the Board or a Federal court, rule 703(e).

Simply filing an RCE should not burden Applicant with loss of term during normal or especially abnormal delays in Office processing of patents, interferences, secrecy orders or appeals; all processes over which the Applicant has no control.

Perhaps, the rules might be changed at 703(b)(1) to "The number of days, if any, in the period in the period beginning on the date four months after the date an RCE was filed and ending on the date of mailing of an action under 35 U.S.C. or a notice of allowance under 35 U.S.C. 151." See e.g., rule 703(a)(2). Such rule would provide proper incentives for the Office to act promptly on RCEs and would preserve advantages of RCE practice without placing a high cost on Applicants for Office delays.

Please consider these comments before the rules are placed in final form.

Respectfully submitted,  
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Reg. No. 38,508